APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,196	02/24/2004	Peter Gernold	13906-114001 / 2003P00306	9245

32864   7590   01/28/2009
FISH & RICHARDSON, P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
HARPER, LEON JONATHAN

ART UNIT	PAPER NUMBER
2166	

NOTIFICATION DATE	DELIVERY MODE
01/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):
PATDOCTC@fr.com

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/784,196
Filing Date: February 24, 2004
Appellant(s): GERNOLD, PETER

_____

Jeremy J. Monaldo (Reg. No. 58,680)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/2008 appealing from the Office action

mailed 4/8/2008.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,870,605	Bracho	2-1999
5,884,324	Cheng et al.	3-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,7,15 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1,10, and 19 of

copending Application No. 10784848. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the subject mater of the instant

application would have been obvious to an artisan of ordinary skill in the pertinent art in

light of the disclosure of application 10784848. Claims 1, 10 and 19 of application

10784848 are directed to receiving information from a user for use in generating data

subscriptions, with steps for receiving, and storing distribution criteria and the type of

data to be distributed and a step for generating data subscriptions based on the type of

data to be distributed (See Application 10784848 claims 1, 10, 19). Claims 1,7,15 of the

instant application are directed to accessing the type of data to be distributed, along

with the distribution criteria and generating data subscriptions based upon the type of

data and the distribution criteria. The instant application would have been obvious to an

artisan of ordinary skill in light of claims 1,10 and 19 of application 10784848 because

once an artisan can receive input identifying the type of data to be distributed, this

information would have to be accessed in order to generate the data distribution.

This is a _provisional_ obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-7, 10-13, 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over US 5870605 (hereinafter Bra) in view of US 5884324

(hereinafter Chen).

As for claim 1 Bra discloses: receive user input identifying a publication to be used to

create data subscriptions, the publication being one of multiple predetermined

publications identifying a type of data capable of being distributed to data sites (See

column 5 lines 9-13). Receive user input identifying a distribution criterion by which

data is to be distributed to data sites by subscriptions automatically generated without

human intervention (See column 6 1-10); Store in computer-readable medium for later

access , subscription-generation information including the identified publication and the

identified distribution criterion (See column 4 lines 50-55) ;

access using a first computer system the subscription-generation information

identifying the publication and distribution (See column 15 lines 13-21 and see column

11 lines 25-30); access , using the first computer system and the accessed

subscription-generation information, application data of various data types including the

type of data identified by the subscription-generation information; (See column 8 lines
40-48); generate using the first computer system data subscriptions for the publication
to be distributed to data sites corresponding to computer systems that are distinct from
the first computer systems, the computer systems and the first computer system being
connected in a network of distributed computer systems operating an application
program having the application data of the various data types (See column 5 lines 9-15)
wherein each data subscription is generated automatically by the first computer system
based only on the type of data to be distributed to data sites, the accessed application
data, and the distribution criterion (See column 5 lines 23-26), generate assignments of
data sites to the generated data subscriptions, the assignments being generated based
on application data, using the first computer system, and automatically without human
intervention (See column 6 lines 1-10):store, in computer-readable medium for later
access, the generated assignments; distribute a portion of the application data to the
data sites corresponding to computer systems the distribution being based on the data
subscriptions generated by the first computer system (See column 12 lines 30-40) and

       While Bra does not differ substantially from the claimed invention the disclosure
of) identifies a portion of the application data to be distributed to one or more of the data
sites of the second computer system is not necessarily explicit. Chen however does
disclose identifies a portion of the application data to be distributed to one or more of
the data sites of the second computer system (See column 3 lines 62-67 note: if
selected). It would have been obvious to an artisan of ordinary skill in the pertinent art to

have incorporated the teachings of Chen into the system of Bra. The modification would

have been obvious because both systems are directed to updating information and

adding the publisher, subscriber model to the data replication system of Cheng would

have made data replication more efficient by allowing replication to be done only when

necessary based on the publisher, subscriber model (See Bra column 1 line 65- column

2 line 5).

As for claim 2, the rejection of claim 1 is incorporated, and further Chen discloses

wherein the one or more code segments are further configured to: access information

related to data sites wherein the data site information includes attributes and attribute

values associated with a particular data site (See column 3 lines 45-50); and associate

a particular data site with a particular data subscription based on the data site

information being related to the portion of application data to be distributed in the

particular data subscription (See column 3 lines 59-64).

As for claim 3, the rejection of claim 1 is incorporated, and further Bra discloses:

wherein the type of data to be distributed to data sites comprises a business object type

(See column 6 lines 19-25).

As for claim 5, the rejection of claim 1 is incorporated, and further Chen

discloses: wherein: the distribution criterion comprises an attribute of the type of data to

be distributed, and the generation of data subscriptions comprises generating data

subscriptions wherein each data subscription is generated based on the attribute of the

type of data to be distributed to data sites (See column 3 lines 46-50).

As for claim 6, the rejection of claim 1 is incorporated, and further Chen

discloses: wherein: the distribution criterion comprises a distribution criterion based on a

relationship of a portion of the application data with an employee that uses a data site

(See column 4 lines 14-17 authorization is a relationship), and the generation of data

subscriptions comprises generating data subscriptions wherein each data subscription

is generated based on the relationship of the portion of the application data with the

employee that uses the data site (See column 3 lines 55-60 note: if the user is not

authorized then no subscription is generated).

Claims 7,10-13 are system claims containing substantially the same limitations

as the computer readable medium claims 1-6 and are thus rejected for the same

reasons as claims 1-3,5-6.

Claims 15-17, 19-20 are method claims corresponding to computer readable

medium claims 1-6 and are thus rejected for the same reasons as set forth in the

rejection of claims 1-6.

(10) Response to Argument

This Examiner's answer will address the arguments in the order in which they
appear in the appeal brief.

Argument (1): Specifically, although Bracho describes a system that enables a
subscriber to choose to subscribe to an event published by a publisher, the Bracho
system does not automatically generate, using a first computer system, data
subscriptions for a publication to be distributed to data sites corresponding to computer
systems that are distinct from the first computer system based only on a type of data to
be distributed to data sites identified by the publication, accessed application data, and
distribution criterion received as user input. Rather, the Bracho system enables
subscribers to "subscribe (or tune in to)" a specific event type based on the subscriber's
interest in the specific event type. See Bracho at col. 5, lines 9-30 and col. 6, lines 1-12.
Therefore, in the Bracho system, data subscriptions are not automatically generated,
using a first computer system, based only on a type of data to be distributed to data
sites identified by the publication, accessed application data, and distribution criterion
received as user input. Moreover, the Bracho system does not generate, based on
application data and using the first computer system, assignments of data sites to the
generated data subscriptions automatically without human intervention. Instead, in the
Bracho system, a subscriber reviews published events available through the Bracho
system and decides which of the published events the subscriber wishes to receive.
See Bracho at col. 5, lines 9-30 and col. 6, lines 1-12. In this regard, generated
subscriptions are not assigned to data sites automatically without human intervention.

In response to argument (1) examiner respectfully submits that Bracho does in

fact teach automatically generating, using a first computer system, data subscriptions

for a publication to be distributed to data sites corresponding to computer systems that

are distinct from the first computer system based only on a type of data to be distributed

to data sites identified by the publication, accessed application data, and distribution

criterion received as user input. There is no debate that the claimed invention receives

user input identifying data or criteria for example claim 1 states "receive user input

identifying a publication to be used to create data subscriptions, the publication being

one of multiple predetermined publications identifying a type of data capable of being

distributed to data sites" So in this limitation user input identifies or defines a publication

to be used to create data subscriptions. Claim 1 further states "receive user input

identifying a distribution criterion by which data is to be distributed to data sites by

subscriptions automatically generated without human intervention." Accordingly here

user input defines a distribution criterion by which data is to be distributed. Examiner

now notes that is only the process of generating data subscriptions for a publication

that is done automatically. Even applicant's arguments state Bracho does not

automatically generate, using a first computer system, data subscriptions for a

publication to be distributed to data sites corresponding to computer systems that are

distinct from the first computer system based only on a type of data to be distributed to

data sites identified by the publication, accessed application data, and ***distribution

criterion received as user input.*** Now turning to the teachings of Bracho. Bracho

discloses that users can specify subscription filters (See Bracho column 8 lines 48-51).

Now the key aspect of this disclosure is that the Subscriber can specify that they only

want to receive events with data in certain fields (See Bracho column 8 lines 48-51).

This means that once the user has specified the distribution fields or criterion the

system will automatically distribute data based on the filter fields or criterion.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

Conclusion

Claims 1-3, 5-7, 10-13, 15-17 , 19 and 20 are properly rejected under 35 U.S.C.

§103(a). In light of the foregoing arguments, the Examiner respectfully request that the

Honorable Board of Appeals sustain the rejections.

Respectfully submitted,

Leon J. Harper

Patent Examiner

Art Unit 2166

Conferees

1.   Hosain Alam, Supervisory Patent Examiner, Art Unit 2166

/Hosain T Alam/

Supervisory Patent Examiner, Art Unit 2166

2.   Eddie, Lee , Technology Center 2100

/Eddie C. Lee/

Supervisory Patent Examiner, TC 2100

Fish & Richardson P.C.
1425 K Street, N.W.
Washington, DC 20005-3500
Tel: (202) 783-5070
Facsimile (877) 769-7945